BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF APPEALS AND INTERFERENCES

In re Application of	:	Raymond S. Bamford et al.
Serial No.	:	09/843,550
Filed	:	4/26/2001
Art Unit	:	3639
Examiner	:	Akiba K. Robinson-Boyce
Title	:	PRICING ENGINE FOR ELECTRONIC COMMERCE
Atty. Docket No.	:	ENOS0003

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APPEAL BRIEF - APPEAL REINSTATED

Responsive to the office action dated June 2, 2006, Applicant reinstates appeal pursuant to MPEP 1204.01. Along with this appeal brief, a new notice of appeal is enclosed. According to MPEP 1204.01, no new appeal fees are due since the notice of appeal and appeal brief are funded by the previously paid fees.

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APPENDICES

REAL PARTY IN INTEREST

Initially, the subject application was assigned by the inventors to Enosys Markets, Inc. by an assignment recorded in the U.S. Patent & Trademark Office on April 26, 2001 at real/frame 011791/0760. Subsequently, due to merger of Enosys Markets, Inc. with a wholly owned subsidiary of BEA Systems, Inc., the application became owned by BEA Systems, Inc. Documentation of the merger was recorded on February 22, 2006 at Reel/Frame 017201/0713.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to be related to the subject patent application.

STATUS OF CLAIMS

Claims 1-25 stand rejected.

STATUS OF AMENDMENTS

There are no un-entered amendments.

SUMMARY OF CLAIMED SUBJECT MATTER

Concise Explanation of Subject Matter

As recommended by MPEP 1206, the following summary of the invention comprises reading of each appealed independent claim on the drawings and specification, to enable the Board to more determine where the claimed subject matter appears in the application. This particular reading is not intended to limit the claims in

any way.

For ease of reference, all Figures of Applicants' drawings are shown in the attached Appendix.

Claim 1

A computer-implemented method (Fig. 2; Abstract) for determining a price of goods made by a manufacturer in response to at least one electronic price request from a buyer for the goods, comprising the acts of:

receiving the electronic price request from the buyer; (Fig. 2, ref. 42; Page 1, last para. – Page 2, first para.; Page 2, second para.; Page 6, second para.; Page 7, second para.)

in response to the electronic price request, performing a computer-executed act of determining whether title to the goods passes directly from the manufacturer to the buyer or through an intermediate e-market place; (Fig. 2, ref. 46; Fig. 3; Page 2, second para.; Page 7, second para.)

computing a price of the goods to the buyer based at least partially on the determining act; (Fig. 3-6; Page 2, second para. – Page 3, second para.; Page 7, last para. – Page 13, last para.)

providing the buyer with a machine-readable signal for displaying the computed price. (Fig. 48, ref. 48; Fig. 3, ref. 70; Page 2, second para. – Page 3, fourth para.)

Claim 9

A computer (Fig. 1; Page 3, third para.; Page 4, second section - Page 6, fourth para.) having logic executable by the computer to perform method acts for determining

a price of goods made by a manufacturer in response to at least one electronic price request from a buyer for the goods, said method acts comprising:

receiving the electronic request from the buyer; (Fig. 2, ref. 42; Page 1, last para. – Page 2, first para.; Page 2, second para.; Page 6, second para.; Page 7, second para.)

in response to the electronic request, determining whether title to the goods passes directly from a manufacturer to a buyer or through an intermediate e-market place; (Fig. 2, ref. 46; Fig. 3; Page 2, second para.; Page 7, second para.)

computing a price of the goods to the buyer based at least partially on the determining act; (Fig. 3-6; Page 2, second para. – Page 3, second para.; Page 7, last para. – Page 13, last para.)

providing the buyer with a machine-readable signal for displaying the computed price. (Fig. 48, ref. 48; Fig. 3, ref. 70; Page 2, second para. – Page 3, fourth para.)

Claim 17

A computer program product (Page 3, fourth para.; Page 6, last para. – Page 7, first para.) having logic means executable by a computer to determine a price of goods made by a manufacturer in response to at least one electronic price request from a buyer for the goods, comprising: computer readable code means for receiving the electronic price request from the buyer;

computer readable code means responsive to receiving the electronic price request for determining whether title to the goods passes directly from the manufacturer to the buyer or through an intermediate e-market place; (Fig. 2, ref. 42, 46; Fig. 3; Page 1, last para. – Page 2, second para.; Page 2, second para.; Page 6, second

para.; Page 7, second para.)

computer readable code means for computing a price of the goods to the buyer based at least partially on the determining; (Fig. 3-6; Page 2, second para. – Page 3, second para.; Page 7, last para. – Page 13, last para.)

computer readable code means for providing the buyer with a machine-readable signal for displaying the computed price. (Fig. 48, ref. 48; Fig. 3, ref. 70; Page 2, second para. – Page 3, fourth para.)

Claim 25

At least one digital data processing machine programmed to cooperatively perform operations for determining a price of goods made by a manufacturer in response to at least one electronic request for quote (RFQ) from a prospective buyer of the goods, the operations comprising:

receiving from the buyer an electronic message comprising an RFQ; (Fig. 2, ref. 42; Page 1, last para. – Page 2, first para.; Page 2, second para.; Page 6, second para.)

responsive to receiving the RFQ, determining a price of the goods based at least partially upon a manufacturer's specification as to whether title to the goods will pass directly from the manufacturer to the buyer or through an intermediate; (Fig. 2, ref. 46; Figs. 3-6; Page 2, second para. – Page 3, second para.; Page 7, second para. & last para. – Page 13, last para.)

transmitting an electronic message representing the determined price to the buyer. (Fig. 48, ref. 48; Fig. 3, ref. 70; Page 2, second para. – Page 3, fourth para.)

Identification of Means Plus Function & Step Plus Function Claims

In accordance with 37 CFR 47.37(c)(1)(v), the following is an identification of all independent and separately argued dependent claims in means (or step) plus function as permitted by 35 USC 112 para. 6: Claims 17, 22.

Corresponding structure, material, or acts is found in and at least the following locations: Fig. 2, ref. 42, 46; Figs. 3-6; Page 1, last para. – Page 3, fourth para.; Page 6, second para. & last para. – Page 7, second para.; Page 7, last para. – Page 13, last para.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following rejection(s) were made in the office action ("Office Action") dated June 2, 2006, a copy of which is enclosed in the Appendix:

Claims 1-25 stand rejected under 35 USC 103 as being unpatentable over the combination of U.S. Patent No. 6,754,636 to Walker et al. ("Walker 636") and U.S. Patent No. 6,332,129 to Walker et al. ("Walker 129").

ARGUMENTS

Introduction

Claims 1-25 were rejected under 35 USC 103 as being unpatentable over the combination of Walker 636 and Walker 129. The claims are patentable since a *prima facie* case of obviousness has not been established, as discussed in greater detail below.[1]

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[1] MPEP 2142.

Teaching/Suggestion of Claim Limitations

First, the *prima facie* obviousness case is incomplete because, even if the references were to be combined as suggested (albeit improperly, as discussed below), the combination still does not teach or suggest all the claim limitations.[2] To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.[3]

All words in a claim must be considered in judging the patentability of that claim against the prior art.[4] Taking claim 1 as an example, the proposed combination of references fails to teach the following combination:

> "A computer-implemented method for determining a price of goods made by a manufacturer in response to at least one electronic price request from a buyer for the goods, comprising the acts of:
>
> receiving the electronic price request from the buyer;
>
> in response to the electronic price request, performing a computer-executed act of determining whether title to the goods passes directly from the manufacturer to the buyer or through an intermediate e-market place;
>
> computing a price of the goods to the buyer based at least partially on the

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2 MPEP 2142, 2143.03.

3 *Ex Parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). MPEP 706.02(j).

4 *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03.

determining act;

providing the buyer with a machine-readable signal for displaying the computed price."

In general, Walker 636 concerns purchasing systems where a buyer purchases goods online, but takes possession at a local retailer. [Walker 636: col. 1, lines 38-44] By aiding buyers to purchase online yet physically collect the goods at a local retailer, Walker's system is said to help manufacturers establish a pricing relationship directly with buyers without establishing their own online service in direct competition with their retailer's tradition distribution channel. [Walker 636: col. 2, lines 48-56] Also, this is said to avoid drawbacks of having to ship products to customers. [Walker 636: col. 2, lines 17-26] Of course, the retailer still receives its money for its part in the transaction. [Walker 636: FIG. 15]

Generally, Walker 129 concerns a conditional purchase offer (CPO) management system. Here, the buyer sets the price for services such as airline tickets, and a CPO management system (such as priceline.com) conveys the offer to sellers for them to either accept or reject. If a seller accepts a buyer's binding conditional purchase offer, this creates a legally binding contract between the buyer and seller. [Walker 129: col. 1, lines 40-60]

The systems of Walker 636 and Walker 129 diverge from claim 1 in a number of important respects, as explained below.

As a more specific example, the applied art does not disclose the claimed combination including an operation of "**receiving the electronic price request**" from a buyer of goods. The office action proposed that this feature is found in Walker 636.

[Office Action: page 2] However, by Walker 636's own language, its purchasing system device 300 acts responsive to a buyer offer, which includes a buyer-defined offer price. Indeed, Walker 636 utilizes a completely different approach, since the buyer proposes a sales price. [Walker 636: col. 5, lines 18-35] See also, Walker 636's col. 7 (lines 48-61), col. 8 (lines 3-30), col. 10 (lines 23-29), FIGS. 12A-12B, col. 12 (lines 29-43), as well as many more occasions. Therefore, in Walker 636 there is no electronic price request.

If someone agrees to the buyer's offer, the buyer pays and a retailer makes the product available to the buyer. In turn, Walker 636's purchasing system pays the retailer a "settlement amount" for its services in providing the product to the buyer. [Walker 636: col. 5, lines 18-35; FIG. 15] According to Walker 636, then, the buyer submits an offer including a buyer-defined offer price. [Walker 636: col. 5, lines 18-35] Clearly then, Walker 636 does not receive an electronic price request, since Walker 636 uses a buyer-submitted offer price instead. Walker 636's buyer-submitted offer price constitutes a request for the seller to accept the offer or not, rather than any sort of price request. [Walker 636: col. 5, lines 28-31] Again, Walker 636 does not disclose any electronic price request.

Moreover, since the so-called seller in Walker 636 responds to the buyer's offer price by accepting or not, this confirms that the buyer-submitted offer price is clearly not a price request. In particular, rather than responding to any price request, Walker 636 endeavors to evaluate a buyer's offer. [Walker 636: col. 19, lines 45-54; FIG. 9E] Namely, Walker 636 attempts to locate a product in the product database 900 that matches the requirements of the buyer offer. If no such product can be found, then the buyer offer will not be accepted. [*Id.*] More particularly, the buyer's offer price is

compared with any minimum price set by the seller. In the event the buyer's offer price is too low, that product will not be used to accept the offer and the process is repeated with respect to other products. [Walker 636: col. 19, lines 55-61] The disclosure of Walker 636 is silent and consequently non-enabling as to what further operations, if any, occur if the buyer's offer is not accepted. [Walker 636: Fig. 9E] In no case, however, does Walker 636 disclose a buyer's electronic price request as claimed.

Aside from the specific language of Walker 636, it would not make any sense for the buyer to submit both an offer price and a price request. The offer price obviates the need for a price request, and is a different thing entirely. Consequently, Walker 636 does not teach "receiving the electronic price request" from a buyer of goods, since Walker 636 teaches a different approach of using a buyer-proposed offer instead.

For a number of reasons, the applied art further fails to show acts of "**in response to the electronic price request, performing a computer-executed act of determining whether title to the goods passes directly from the manufacturer to the buyer or through an intermediate e-market place**." The office action proposed that such features are found in Walker 636. [Office Action: page 2] Nevertheless, a careful analysis of Walker 636 reveals otherwise. First, since Walker 636 does not teach the claimed electronic price request (as discussed above), Walker 636 necessarily does not show any action "in response to the electronic price request...," let alone the claimed feature "determining whether title to the goods passes..."

Second, the disclosure of Walker 636 does not mention "title" even once, and further does not provide any enabling disclosure as to determining how title passes. Nonetheless, it is clear that title always passes from the retailer to the buyer, despite Walker's misleading reference to other parties than the retailer as "sellers." The retailer

of Walker 636 already has goods on its shelves, for sale to walk-in customers; hence, the retailer clearly has title, and is the only true seller. [Walker 636: col. 5, line 66 – col. 6, line 4] Aside from walk-in customers, then, Walker 636 merely addresses an additional mechanism for the advertising these products, namely by an online "seller" (who reimburses the retailer if a sale is made) and/or by the retailer itself online. In any case, Walker 636 does not care about how title passes, since title goes from the retailer to the buyer in all cases.

Thus, Walker 636 merely facilitates more competitive pricing on goods by offering a system whereby different non-title-bearing entities (Walker 636's so-called "sellers") agree to provide different subsidies, kickbacks, settlements, or other subsidies to the retailer that actually holds title to the goods. By aiding buyers to purchase online yet physically collect the goods at a local retailer, Walker's system is said to help manufacturers establish a pricing relationship directly with buyers without establishing their own online service in direct competition with their retailer's tradition distribution channel. [Walker 636: col. 2, lines 48-56] In other words, the sale is still consummated by the retailer in all cases.

It is further clarified that title passes from retailer to buyer directly because of Walker's 636 admitted applicability of state or city sales tax. [Walker 636: col. 27, lines 54-68 and col. 28, lines 1-10; Fig. 21D] If title passed directly from an out-of-state manufacturer to a local buyer, there would be no state sales tax. Accordingly, Walker 636 does not teach "in response to the electronic price request, performing a computer-executed act of determining whether title to the goods passes directly from the manufacturer to the buyer or through an intermediate e-market place."

The office action cited Walker 636's column 20, lines 30-64 as being pertinent to

determining how title to goods passes. [Office Action: page 2] However, a careful reading of the cited passage reveals a different teaching. Namely, the seller database 1000 (Fig. 10A) is merely used to determine whether the so-called "seller" is the physical retailer or a remote party. [Walker 636: col. 20, lines 34-35] In either case, however, the retailer still has title since the retailer is holding the goods on their shelves, and offering them for sale to walk-in retail customers. [Walker 636: col. 5, line 66 - col. 6, line 4] Therefore, the seller database 1000 is merely a tool to determine whether a number of settlement prices or a single price should be used when determining whether a buyer offer will be accepted. In any case, Walker 636 still does not care about how title passes, since title universally passes from the retailer to the buyer.

The applied art further lacks the claimed operation of "**computing a price of the goods to the buyer based at least partially on the determining act**" (i.e., the act of determining how title to goods passes). The office action proposed that this operation is disclosed by Walker 129. [Office Action: page 3] In this regard, the office action characterized Walker 129 as disclosing that a price determination is made as a result of the customer obtaining an airline package directly from the manufacturer instead of making the purchase through the website on the Internet. [Office Action: page 3]

A more careful reading of Walker 129, however, reveals that this characterization of Walker 129 is in error.

Walker 129 does not contain any meaningful disclosure relating to "goods." Walker 129's chief example concerns airline tickets, clearly a service of delivering a person from point-A to point-B rather than any "goods." Although Walker 129 repeatedly uses "goods and services" in a blanket description, Walker 129's examples are limited to services. Thus, Walker 129 does not show "computing a price of the

goods..."

At best, Walker 129's relation to the sale of goods is nonenabling. Yet, a reference itself must sufficiently describe the claimed invention to have placed the public in possession of it.[5] Even if a claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling.[6] In order to anticipate, a prior art reference must be enabling, thus placing the allegedly disclosed subject matter in the possession of the public.[7] The reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of invention in possession of it.[8]

Further, Walker 129 fails to show "computing a price of the goods... based at least partially on" the act of determining how title to goods passes. As Walker 129 does not contain any meaningful disclosure of the sale of goods, Walker 129 quite clearly lacks any teaching of how title to goods would pass. Walker 129 lacks even a single use of related words such as "title", "ownership," "manufacturer," etc. The office action likened Walker 129's airline to a manufacturer. [Office Action: page 3] This goes too far- - the suggestion that an airline is a manufacturer of goods is untenable. Thus, Walker does not show "computing a price of the goods... based at least partially on" the act of determining how title to goods passes.

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5 *Paperless Accounting, Inc. v. Bay Area Rapid Transit System*, 231 USPQ 649, 653 (Fed. Cir. 1986). *Ex parte Gould*, 231 USPQ 421 (CCPA 1973).

6 *Id.*

7 *Akzo N.V. v. United States ITC*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986); *Ashland Oil, Inc. v. Delta Resins & Refracs., Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *Reading & Bates Constr. Co. v. Baker Energy Res. Corp.*, 748 F.2d 645, 223 USPQ 1168 (Fed. Cir. 1984)

8 *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990).

Indeed, Walker 129 teaches away from "computing a price of the goods... based at least partially" upon the act of determining how title to goods passes since, with Walker 129, the transaction occurs between seller and buyer. Therefore, computing price based on how title passes in Walker 129 would be nonsensical. In particular, Walker 129 concerns a conditional purchase offer (CPO) management system. Here, the buyer sets the price, and a CPO management system (such as priceline.com) conveys the offer to sellers for them to either accept or reject. If a seller accepts a buyer's binding conditional price offer, this creates a legally binding contract between the buyer and seller. [Walker 129: col. 1, lines 40-60] Walker 129 monitors whether a seller accepts a buyer's conditional purchase offer, and if so, provides the seller with the buyer's personal information in order to complete the transaction. [Walker 129: ref. 865, Fig. 6B; ref. 1085, Fig. 7C]

As for consumers whose offers are unacceptable and subsequently rejected by the airlines, customer service representatives of the CPO management system (i.e., priceline.com) contact the customers and propose counter-offers on behalf of the sellers. [Walker 129: col. 2, lines 16-29] Similarly, Walker 129's "package counter-offers" are also generated and presented by the CPO management system on behalf of sellers. [Walker 129: col. 2, lines 40-53] Thus, even with counter-offers and package counter-offers, the CPO simply acts on behalf of the sellers, and namely, to generate and convey an offer to buyers. Whether the seller accepts the buyer's conditional purchase offer or the buyer accepts the seller's counter offer, the contract is between the Walker 129's buyer and seller. Hence, price in no way varies depending depend upon the claimed "determining act," that is, the act of determining how title to goods passes. Accordingly, Walker 129 teaches away from "computing a price of the goods...

based at least partially on" the act of determining how title to goods passes, since Walker 129's transaction is always conducted directly between seller and buyer.

Nor is the claimed feature ("computing a price of the goods to the buyer based at least partially on the determining act") found in Walker 636. Lacking the operation of determining how title to goods passes (as discussed above), Walker 636 necessarily does not show computing a price of goods based at least partially upon such act. Critically, Walker 636's buyer sets his/her own price, and Walker's purchase system is said to find a so-called "seller" (if any) capable of providing the requested goods at that price. More accurately, Walker 636's purchase system searches to find a party that is able to provide a sufficient subsidy to the retailer (the true seller) so that the buyer's ultimate purchase price (at the retailer) meets the buyer's offer. In any case, Walker 636 does not compute the goods' price based on how title passes. Rather, as discussed below, Walker simply determines whether to accept the buyer's price or not. [Walker 636: Abstract]

As Walker 636 evaluates products that might meet the buyer's offered price, Walker 636 purportedly does consider whether a product's so-called "seller" is also the manufacturer (ref. 953, FIG. 9E; FIG. 10A). If the "seller" is the retailer, the retailer's price is simply used to evaluate the buyer's offer (ref. 956, FIG. 9E); if the manufacturer is the "seller," various retailers must be considered to determine which retailer to use, or even whether the buyer's offer should be rejected (ref. 954-955, FIG. 9E). However, in no case does Walker 636 compute a price of goods based on how title passes. In fact, Walker 636's ultimate output is not the price of goods to the buyer, but rather a decision of whether to accept the buyer's offer. [Walker 636: ref. 955, FIG. 9E]

In a different context, Walker 636 again considers whether the "seller" is the

manufacturer. [Walker 636: ref. 1062, FIG. 10B] In this case, the seller/manufacturer inquiry is made during the process of determining how much to pay the retailer (as opposed to the sales price to the buyer). In the case of a manufacturer seller, the settlement price is provided to the retailer at 1063. On the other hand, when the retailer also acted as the seller, the buyer price may simply be provided to the retailer. [Walker 636: col. 20, lines 45-64; refs. 1062-1064, FIG. 10B] Therefore, step 1062 merely asks whether the so-called "seller" is the manufacturer in order to assess payment due to the retailer (who holds title). This has nothing to do with the claimed feature "computing the price of goods to the buyer..." Consequently, Walker 636 fails to teach computing a price of the goods to the buyer based at least partially on the act of determining how title to goods passes, as claimed.

Although Walker 636 purportedly maintains a pricing database 2000 containing figures such as retail price and settlement price (FIG. 20), this has nothing to do with computing price of goods to the buyer. Rather than having anything to do with Walker 636's online purchasing system 300, the database 2000 merely serves as an example of a database that might be kept by a local retailer in order to keep track of their own prices to be charged to a typical buyer of the street ("retail prices" 2020), and also to track prices that the retailer should expect in exchange for redeeming a voucher for one of Walker's online purchasing system 300 customers. [Walker 636: col. 26, lines 13-28] These prices have no relation to the actions of Walker's online purchasing system 300 in making sales to buyers. Furthermore, Walker 636 contains no disclosure about how prices in the database 2000 are computed, let alone, that they might be computed "... at least partially on the determining act", that is, the act of determining how title to goods passes, as claimed. For these reasons, Walker 636 clearly lacks the claimed

operation "computing a price of the goods to the buyer based at least partially on the determining act."

Finally, the applied art does not teach "**providing the buyer with a machine-readable signal for displaying the computed price**." The office action proposed that such feature is found in Walker 636. [Office Action: page 2] This proposal is untenable, for the following reasons. Walker 636 fails to compute a price of goods to the buyer, as discussed above, because the source of Walker's price of goods is the buyer's offer. Walker 636 would have no need to provide the buyer with a computed price online, since the price originated from the buyer. As discussed above, Walker 636's consideration of whether the "seller" was a manufacturer was merely used to determine whether to accept the buyer's offer (ref. 955, FIG. 9E) or to determine how much to pay the retailer (ref. 1063-1064, FIG. 10B). In no case does Walker 636 provide an output price to the buyer.

The office action suggested that Walker's column 33, lines 63 through column 34, line 3 discloses the display of a price of goods. [Office Action: pages 2-3] The cited passage, however, merely describes how the buyer receives a receipt when taking possession from the retailer. However, there is no discussion of "providing the buyer with a machine-readable signal for displaying the computed price." Rather, a point-of-sale (POS) register issues the buyer a paper receipt containing store price, product identifier, and the like. [Walker 636: col. 33, lines 63-67] The cited passage does not teach "providing the buyer with a machine-readable signal for displaying the computed price" as claimed.

Accordingly, for the foregoing reasons, claim 1 is patentably distinguished from the applied art.

Independent Claims 9, 17

For similar reasons, independent claims 9 and 17 are also patentably distinguished from Walker.

Independent Claim 25

Claim 25 is patentable under the same rationale, and for additional reasons as well. For instance, the applied art does not teach "**receiving from the buyer an electronic message comprising an RFQ**." The office action proposed that this operation is disclosed in Walker 636. [Office Action: page 10] As discussed in detail above, Walker 636 evaluates a buyer proposed purchase price and accepts it or not. Walker 636 fails to disclose a buyer-submitted request-for-quote.

Furthermore, the applied art does not teach "**responsive to receiving the RFQ, determining a price of the goods based at least partially upon a manufacturer's specification as to whether title to the goods will pass directly from the manufacturer to the buyer or through an intermediate**." The office action proposed that this feature is found in Walker 129. [Office Action: page 11] Walker 129's own words, however, reveal otherwise in a number of respects. First, rather than a buyer's "RFQ" as claimed, Walker 129 uses a buyer's binding conditional purchase offer, as discussed above in detail. The buyer's request, if anything, is a request for someone to accept his/her offer. Second, rather than the sale of "goods" as claimed, Walker 129's disclosure is aimed at the sale of airline tickets. Third, rather than addressing "whether title to goods will pass directly from the manufacturer to the buyer or through an

intermediate" as claimed, the disclosure of Walker 129 is limited to a legally binding contract between the buyer and seller. [Walker 129: col. 1, lines 40-60] Fourth, Walker 129 does not disclose any "manufacturer's specification" as to how title to goods passes, since (1) the deal occurs between seller to the buyer, (2) Walker 129 lacks a manufacturer, since only services are disclosed.

Accordingly, claim 25 is patentable *a fortiori* relative to the reasons given above for patentability of independent claims 1, 9, and 17.

Dependent Claims 6, 14, 22

Moreover, even without considering any individual merits of dependent claims 2-8, 10-16, and 18-24, these claims are distinguished because they depend from independent claims 1, 9, or 17, which are distinguished as discussed above.[9]

Nonetheless, an example is given to show features of these dependent claims that even further distinguish over the applied art. Namely, as to claims 6, 14, and 22, the applied art fails to teach the method of determining the price of goods from claim 1 "wherein a discount is determined based on at least one of: an advance scheduling of an order, an industry segment of the buyer, a credit rating of the buyer, and a stocking/handling charge." The office action suggested that Walker 636's consideration of a buyer's address or location somehow constitutes discount determined based on a stocking/handling charge. [Office Action: page 4] Without more, there would not seem to any relation between the buyer's address or location and a stocking/handling charge.

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9 *Cf.* If an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

Retailers would have a flat fee for handling or stocking, not one that would discriminate against people based on where they live. The suggested reading of Walker 636 is unsupported by Walker's figures and text, and it might be illegally discriminatory under state or federal law. Consequently, there is nothing in Walker 636 that discloses "wherein a discount is determined based on at least one of: an advance scheduling of an order, an industry segment of the buyer, a credit rating of the buyer, and a stocking/handling charge," as claimed. Accordingly, claims 6, 14, 22 are patentable *a fortiori* relative to the reasons given above for patentability of independent claims 1, 9, and 17.

Conclusion - Teaching/Suggestion of Claim Limitations

In view of the foregoing, all pending claims in the application are patentably distinguished over the applied art.

Suggestion or Motivation

In addition to the reasons given above, the *prima facie* obviousness case is also defective because there has been no suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.[10]

Non-Analogous Art

The references cannot be properly combined because Walker 129 concerns

[10] PEP 2142.

non-analogous art to the present invention.

For the teachings of a reference to be prior art under 35 USC 103, there must be some basis for concluding that the reference would have been considered by one skilled in the particular art working on the particular problem with which the invention pertains.[11] Non-analogous art cannot properly be pertinent prior art under 35 USC 103.[12] The determination of whether a reference is from a non-analogous art is set forth in a two-step test provided by *Union Carbide Corp. v. American Can Co.*[13] In *Union Carbide*, the court found that the first determination was whether "the reference is within the field of the inventor's endeavor." If it is not, one must proceed to the second step "to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved." In regard to the second step, "analogous art is that field of art which a person of ordinary skill in the art would have been apt to refer in attempting to solve the problem solved by a proposed invention."[14] "To be relevant the area of art should be where one of ordinary skill in the art would be aware that similar problems exist."[15]

Walker 129 is outside the field of the inventor's endeavor. The field of the present inventors' endeavor (in the example of claim 1) relates to determining a price of goods made by a manufacturer in response to a buyer's request. Walker 129,

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11 *In re Horne*, 203 USPQ 969, 971 (CCPA 1979).

12 *In re Pagliaro*, 210 USPQ 888, 892 (CCPA 1981).

13 724 F.2d 1567, 220 USPQ 584 (Fed. Cir. 1984)

14 *Bott v. Fourstar Corp.*, 218 USPQ 358 (E.D. Mich. 1983).

15 *Id.*

however, has no need to determine price because Walker 129's buyer has already fixed the price via binding conditional price offer. Therefore, the only request of Walker 129's buyer is for the seller to accept his/her binding offer.

In addition, Walker 129 is not concerned with the particular problem confronting the present inventors. The present inventors were confronted with the problem presented when an electronic market places sells goods from many manufacturers, having have their own title and pricing policy. Some manufacturers, for instance, might desire that the e-market place actually take interim title to the goods, while other manufacturers might desire title to pass directly from the manufacturer to the buyer. A variable that flows from the manufacturer's title passing preferences is that of pricing, that is, whether the manufacturer determines the final price, or the e-market place. [Original Specification: pages 1-2]

In contrast, Walker 129 was concerned with a completely different problem, namely, the problem of how to increase the acceptance rate of consumer offers while simultaneously managing a finite subsidy budget in a cost-effective manner. [Walker 129: col. 3, lines 20-25] To this end, Walker 129 utilizes a psychographic questionnaire to gather and assess buyer's needs and purchasing patterns. Information gathered by the questionnaire is used, for example, to determine actions that may be applied to the buyer's offer before presenting to potential sellers, or to propose a counter-offer of changed prices back to the buyer. [Walker 129: Abstract]

Accordingly, Walker 129 was not concerned with the particular problem confronting the present inventors. As further evidence of nonanalogy, Applicant's invention is preliminarily classified in class 705/400, whereas Walker 129 is classified in 705/26. MPEP 2141.01(a)

Thus, the proposed combination of Walker 636 and Walker 129 is improper because Walker 129 concerns non-analogous art to the present invention.

Proposed Modification of Walker 636 Does Not Make Sense

The office action proposed that it would have been obvious to one of ordinary skill in the art to modify Walker 636 by incorporating the teachings of Walker 129, the motivation being "showing that the price will vary according to whether or not the buyer purchased goods directly from the manufacturer, or through an intermediate e-market place." [Office Action: pages 3-4]

This proposal is insufficient to constitute a *prima facie* obviousness because, for a number of various reasons, it does not make sense. First, the teachings of Walker 636 are limited to buyers' purchases from the retailer. Walker 636 does not contemplate buying directly from the manufacturer. Walker 636's disclosure does not mention "title" even once, and further does not provide any enabling disclosure as to determining how title passes. Yet, it is clear that ownership always passes from Walker 636's retailer to the buyer. Walker 636's retailer already has goods on their shelves for sale to walk-in customers, thus the retailer owns these goods. [Walker 636: col. 5, line 66 – col. 6, line 4] Aside from walk-in customers, Walker 636's disclosure merely introduces an additional mechanism for selling these products, namely by an online seller (who reimburses the retailer if a sale is made) or by the retailer itself online. In any case, Walker 636 does not care about how title passes, since title presumably goes from the retailer to the buyer in all cases. It is further clear that title passes from retailer to buyer directly because of the admitted applicability of state or city sales tax. [Walker 636: col. 27, lines 54-68 and col. 28, lines 1-10; Fig. 21D] If title passed directly from

an out-of-state manufacturer to a local buyer, there would be no state sales tax. Therefore, the notion of "showing that the price will vary according to whether or not the buyer purchased goods directly from the manufacturer..." is foreign to Walker 636, which merely facilitates more competitive pricing on goods by offering a system whereby different non-title-bearing entities (Walker 636's so-called "sellers") agree to provide different subsidies, kickbacks, settlements, or other subsidies to the retailer that actually holds title to the goods.

Second, the Examiner's proposed modification of Walker 636 does not make sense because, Walker 636's buyer sets the price with its offer. Walker 636's purchasing system device 300 acts responsive to a buyer offer, which includes a buyer-defined offer price. Indeed, Walker 636's buyer proposes a sales price. [Walker 636: col. 5, lines 18-35] See also, Walker's col. 7 (lines 48-61), col. 8 (lines 3-30), col. 10 (lines 23-29), FIGS. 12A-12B, col. 12 (lines 29-43), as well as many more occasions. If a seller agrees to the buyer's offer, the buyer pays and a retailer makes the product available to the buyer. Walker 636's purchasing system, in turn, pays the retailer a "settlement amount" for its services in providing the product to the buyer. [Walker 636: col. 5, lines 18-35; FIG. 15] According to Walker 636, then, the buyer submits an offer including a buyer-defined offer price. [Walker 636: col. 5, lines 18-35] Clearly then, Walker 636's price arises from the buyer-submitted offer. And, Walker 636's buyer-submitted offer price constitutes a request for the seller to accept the offer or not, rather than any sort of price request. [Walker 636: col. 5, lines 28-31] Therefore, the suggestion of "showing that the price will vary..." is irrelevant to Walker 636 because the price does not vary- - it is fixed by the buyer's binding offer.

Moreover, the proposed modification is further insufficient to constitute a *prima*

facie case of obviousness because the proposed modification would necessarily change the principle of operation of Walker 636.[16] Modifying Walker 636 in order to show that the price will vary according to whether or not the buyer purchased goods directly from the manufacturer, or through an intermediate e-market place, would completely change Walker 636's principle of operation, requiring a substantial redesign and reconstruction of Walker 636's elements.[17] As mentioned above, Walker 636's price is (by design) set the buyer, and further insensitive to hidden relationship among Walker 636's seller, retailer, manufacturer, etc.

Conclusion - Suggestion or Motivation

In view of the foregoing, the *prima facie* obviousness case is lacking because there has not been a legally sufficient showing of suggestion or motivation to combine reference teachings.

Reasonable Expectation of Success

In addition to the reasons stated above, the *prima facie* obviousness case is further defective because the office action failed to show that there would be a reasonable expectation of success in modifying/combining references.[18] Critically, to establish a *prima facie* case of obviousness, *there must be a reasonable expectation of*

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16 *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP 2143.01.

17 MPEP 2143.01.

18 MPEP 2142, 2143.02.

success.[19] This reasonable expectation of success must be found in the prior art, not in Applicant's disclosure.[20]

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.[21] If the Examiner does not produce a prima facie case, the applicant is under *no* obligation to submit evidence of nonobviousness.[22]

Nowhere in the office action is there any mention of the legally required "reasonable expectation of success." Since this mandatory topic is unaddressed by the office action, no *prima facie* case of obviousness has been properly established.

Furthermore, an ordinarily skilled artisan would not enjoy reasonable prospects of success in carrying out the proposed modification because Walker 636 and Walker 129, as discussed above, employ completely different and inconsistent approaches. Neither the office action nor the cited art shows how Walker 636 could somehow be modified by incorporating the completely inconsistent teaching of Walker 129. Moreover, there has been no suggestion that such a combination is even possible. Rather, the fundamental differences between Walkers 636/129 suggest that there would be a poor expectation of success to be realized by combining the references.

Conclusion

As shown above, then, these claims are patentable since a *prima facie* case of

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19 MPEP 2143.

20 *In re Vaeck*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991). MPEP 2143.

21 MPEP 2142.

22 *Id.*

obviousness does not exist. Namely, (1) the applied art fails to teach the features of the claims, (2) there is insufficient motivation to combine/modify references as proposed by the office action, and (3) there is no showing that an ordinarily skilled artisan would have a reasonable expectation of success in making the office action's proposed modification of references. Accordingly, the Examiner should be reversed and ordered to pass the case to issue.

If any fees are required by this submission, an appropriate fee submittal sheet is enclosed herewith. If fees are required yet this sheet is inadvertently missing, or the fees are incorrect in amount, please charge the charge the required fees (or credit any overpayment) to Deposit Account No. 07-1445.

Respectfully submitted,

Jeffrey Brill
Reg. No. 51,198

Customer 22,862

CLAIMS APPENDIX

1. A computer-implemented method for determining a price of goods made by a manufacturer in response to at least one electronic price request from a buyer for the goods, comprising the acts of:

receiving the electronic price request from the buyer;

in response to the electronic price request, performing a computer-executed act of determining whether title to the goods passes directly from the manufacturer to the buyer or through an intermediate e-market place;

computing a price of the goods to the buyer based at least partially on the determining act;

providing the buyer with a machine-readable signal for displaying the computed price.

2. The method of Claim 1, wherein a first pricing regime is implemented when it is determined that title to the goods passes directly from the manufacturer to the buyer.

3. The method of Claim 2, wherein when it is determined that title passes through an intermediate e-market place, the method further includes determining whether to implement the first pricing regime or a second pricing different than the first pricing regime.

4. The method of Claim 3, further comprising the act of:

determining whether to discount a price.

5. The method of Claim 4, wherein a discount is determined based on at least one of: volume of a current order, volume of annual orders, and projected volume of orders.

6. The method of Claim 4, wherein a discount is determined based on at least one of: an advance scheduling of an order, an industry segment of the buyer, a credit rating of the buyer, and a stocking/handling charge.

7. The method of Claim 3, further comprising the act of:

determining whether to customize a price.

8. The method of Claim 7, wherein the price is customized based on at least one of: geographic region, customer information, product line information, manufacturer information.

9. A computer having logic executable by the computer to perform method acts for determining a price of goods made by a manufacturer in response to at least one electronic price request from a buyer for the goods, said method acts comprising:

receiving the electronic request from the buyer;

in response to the electronic request, determining whether title to the goods passes directly from a manufacturer to a buyer or through an intermediate e-market place;

computing a price of the goods to the buyer based at least partially on the

determining act;

providing the buyer with a machine-readable signal for displaying the computed price.

10. The computer of Claim 9, further including logic for executing a method act comprising:

implementing a first pricing regime when it is determined that title to the goods passes directly from the manufacturer to the buyer.

11. The computer of Claim 10, further including logic for executing a method act comprising:

when it is determined that title passes through an intermediate e-market place, determining whether to implement the first pricing regime or a second pricing regime.

12. The computer of Claim 11, further including logic for executing a method act comprising:

determining whether to discount a price.

13. The computer of Claim 12, wherein a discount is based on at least one of: volume of a current order, volume of annual orders, and projected volume of orders.

14. The computer of Claim 12, wherein a discount is based on at least one of: an advance scheduling of an order, an industry segment of the buyer, a credit rating of

the buyer, and a stocking/handling charge.

15. The computer of Claim 11, further including logic for executing a method act comprising:

determining whether to customize a price.

16. The computer of Claim 15, wherein the price is customized based on at least one of: geographic region, customer information, product line information, manufacturer information.

17. A computer program product having logic means executable by a computer to determine a price of goods made by a manufacturer in response to at least one electronic price request from a buyer for the goods, comprising:

computer readable code means for receiving the electronic price request from the buyer;

computer readable code means responsive to receiving the electronic price request for determining whether title to the goods passes directly from the manufacturer to the buyer or through an intermediate e-market place;

computer readable code means for computing a price of the goods to the buyer based at least partially on the determining;

computer readable code means for providing the buyer with a machine-readable signal for displaying the computed price.

18. The computer program product of Claim 17, further including:

computer readable code means for implementing a first pricing regime when it is determined that title to the goods passes directly from a manufacturer to a buyer.

19. The computer program product of Claim 18, further including:

computer readable code means for determining whether to implement the first pricing regime or a second pricing regime when it is determined that title passes through an intermediate e-marketplace.

20. The computer program product of Claim 19, further including:

computer readable code means for determining whether to discount a price.

21. The computer program product of Claim 20, wherein a discount is based on at least one of: volume of a current order, volume of annual orders, and projected volume of orders.

22. The computer program product of Claim 21, wherein a discount is based on at least one of: an advance scheduling of order, an industry segment of the buyer, a credit rating of the buyer, and a stocking/handling charge.

23. The computer program product of Claim 19, further including:

computer readable code means for determining whether to customize a price.

24. The computer program product of Claim 23, wherein the price is customized based on at least one of: geographic region, customer information, product line information, manufacturer information

25. At least one digital data processing machine programmed to cooperatively perform operations for determining a price of goods made by a manufacturer in response to at least one electronic request for quote (RFQ) from a prospective buyer of the goods, the operations comprising:

receiving from the buyer an electronic message comprising an RFQ;

responsive to receiving the RFQ, determining a price of the goods based at least partially upon a manufacturer's specification as to whether title to the goods will pass directly from the manufacturer to the buyer or through an intermediate;

transmitting an electronic message representing the determined price to the buyer.

EVIDENCE APPENDIX

(none)

RELATED PROCEEDINGS APPENDIX

(none)

APPENDIX A

Applicant's Figures

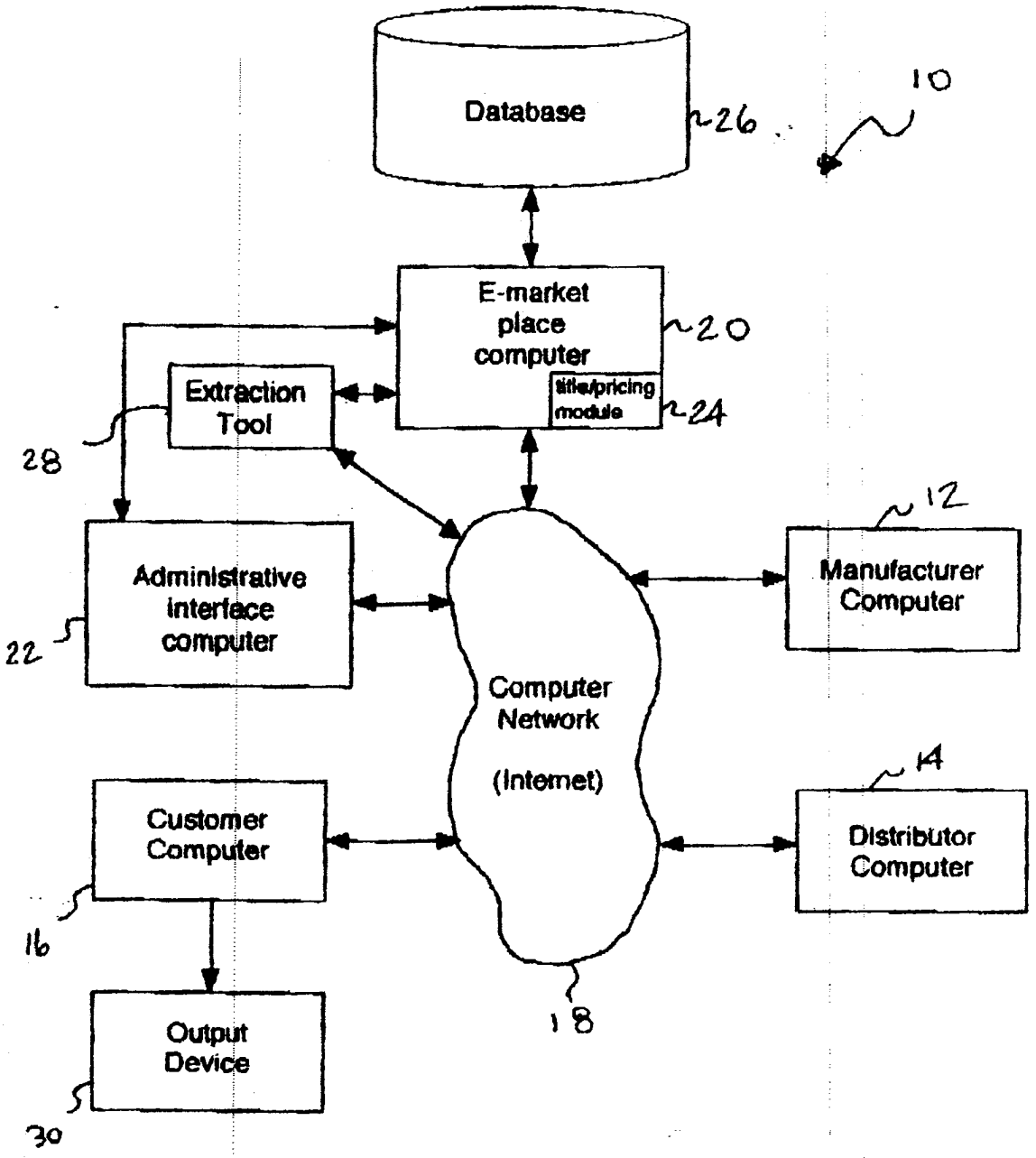
Database
26
10
E-market place computer
20
title/pricing module
24
Extraction Tool
28
Administrative interface computer
22
12
Manufacturer Computer
Computer Network
(Internet)
14
Distributor Computer
Customer Computer
16
Output Device
30
18

FIG. 1

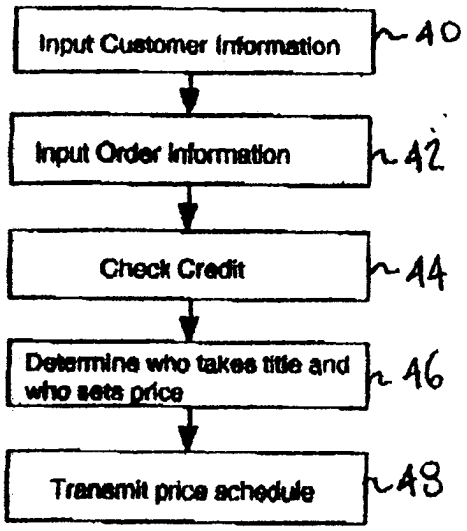
Input Customer Information
40
Input Order Information
42
Check Credit
44
Determine who takes title and who sets price
46
Transmit price schedule
48

FIG. 2

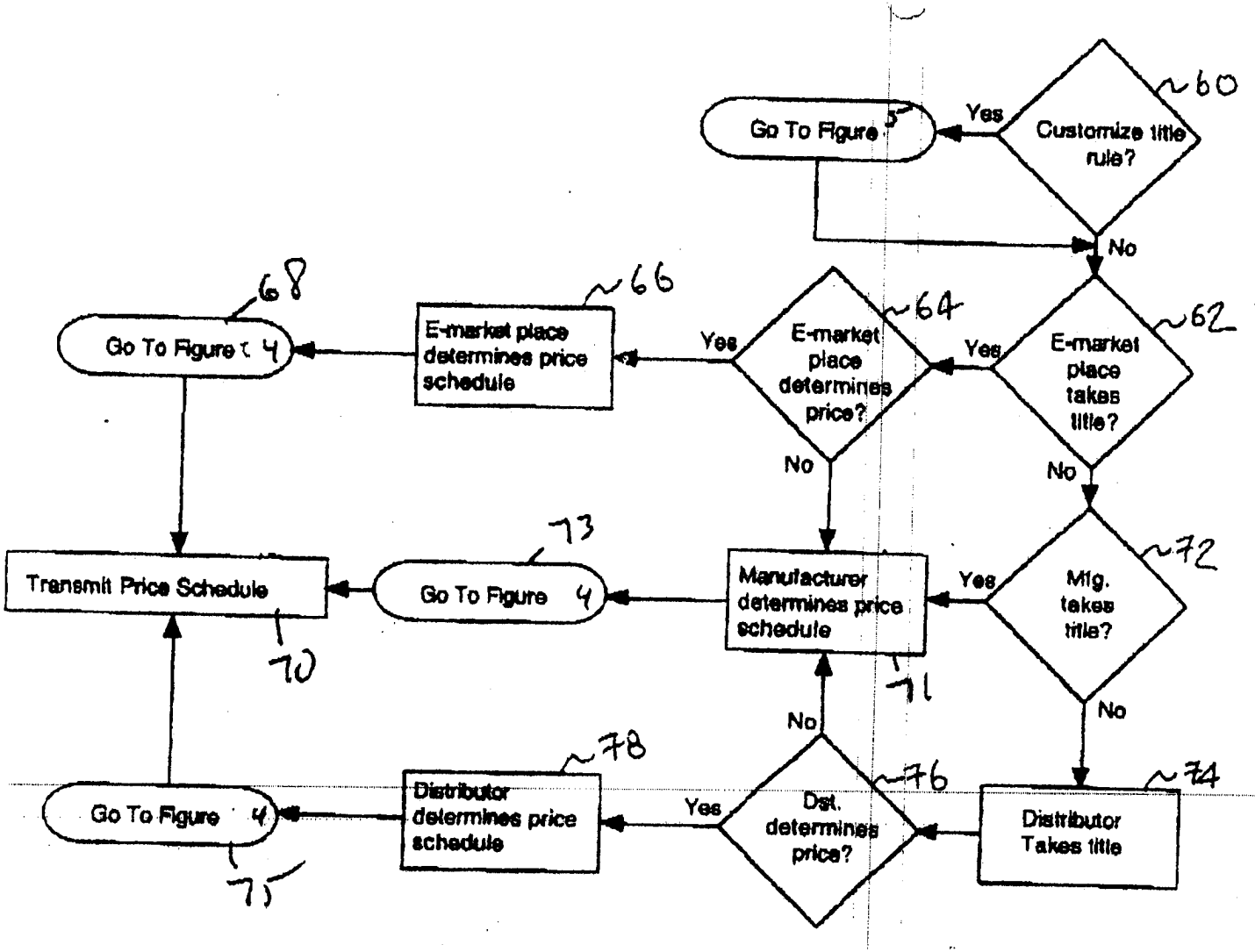
Go To Figure 5
Yes
Customize title rule?
60
No
Go To Figure 4
68
E-market place determines price schedule
66
Yes
E-market place determines price?
64
Yes
E-market place takes title?
62
No
No
Transmit Price Schedule
70
Go To Figure 4
73
Manufacturer determines price schedule
71
Yes
Mfg. takes title?
72
No
Go To Figure 4
75
Distributor determines price schedule
78
Yes
Dst. determines price?
76
No
Distributor Takes title
74

Figure 3

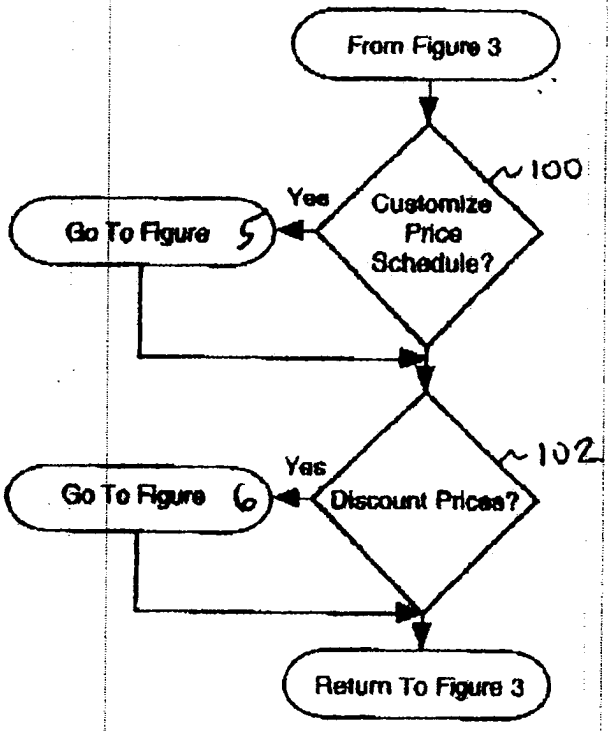
From Figure 3
100
Customize Price Schedule?
Yes
Go To Figure 5
102
Discount Prices?
Yes
Go To Figure 6
Return To Figure 3

FIG. 4

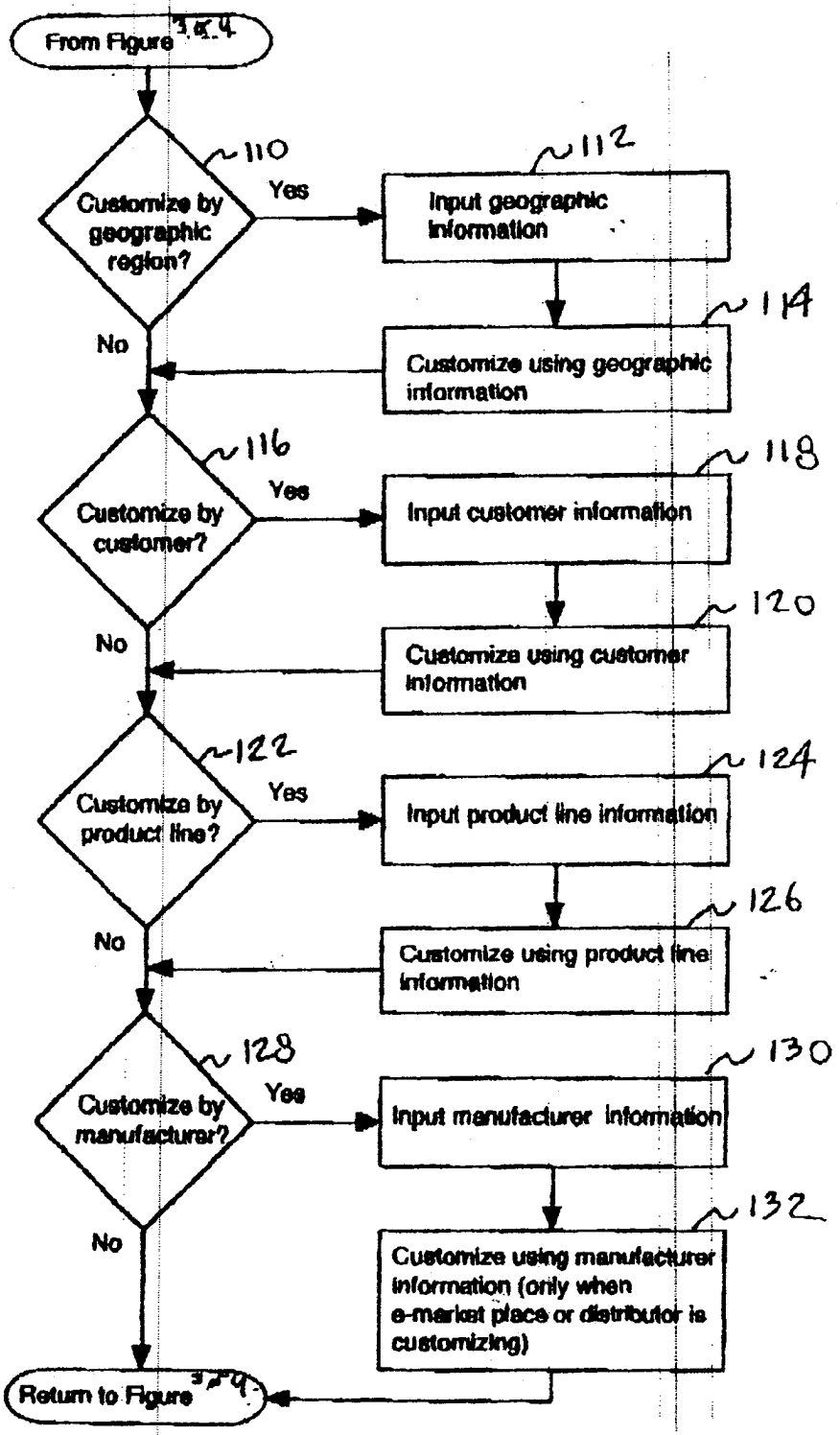
From Figure 3 & 4
110
Customize by geographic region?
Yes
112
Input geographic information
No
114
Customize using geographic information
116
Customize by customer?
Yes
118
Input customer information
No
120
Customize using customer information
122
Customize by product line?
Yes
124
Input product line information
No
126
Customize using product line information
128
Customize by manufacturer?
Yes
130
Input manufacturer information
No
132
Customize using manufacturer information (only when e-market place or distributor is customizing)
Return to Figure 3 & 4

Figure 5

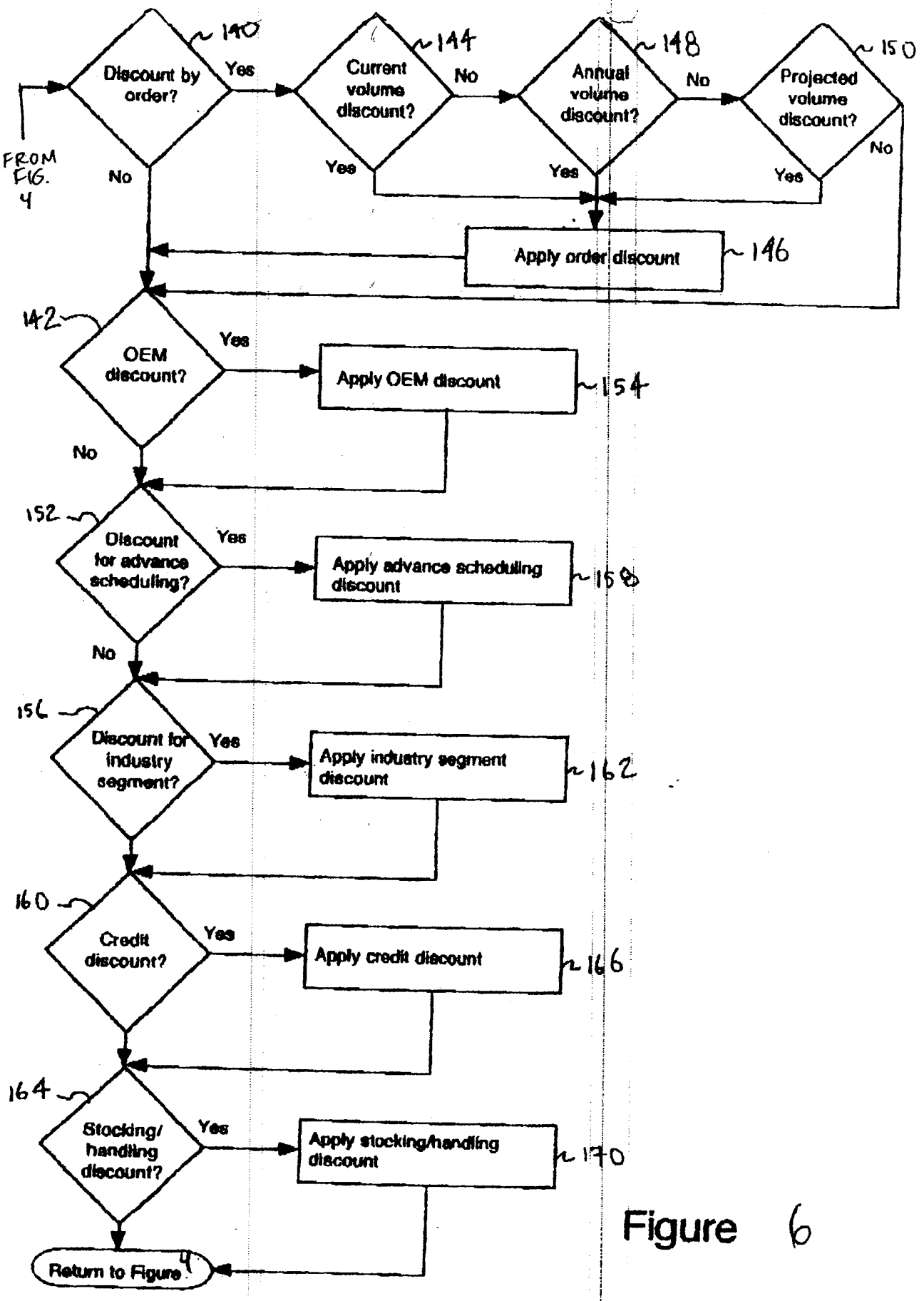
FROM FIG. 4
140
Discount by order?
Yes
No
144
Current volume discount?
Yes
No
148
Annual volume discount?
Yes
No
150
Projected volume discount?
Yes
No
Apply order discount
146
142
OEM discount?
Yes
No
Apply OEM discount
154
152
Discount for advance scheduling?
Yes
No
Apply advance scheduling discount
158
156
Discount for industry segment?
Yes
No
Apply industry segment discount
162
160
Credit discount?
Yes
No
Apply credit discount
166
164
Stocking/ handling discount?
Yes
No
Apply stocking/handling discount
170
Return to Figure 4

Figure 6

APPENDIX B

Office Action dated June 2, 2006

ENOS0003

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,550	04/26/2001	Raymond S. Bamford	ENSY-004	9238

22862 7590 06/02/2006

GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

ACKNOWLEDGE RECEIPT
JUN - 5 2006
GLENN PATENT GROUP

EXAMINER	
ROBINSON BOYCE, AKIBA K	
ART UNIT	PAPER NUMBER
3639	

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

GPG
U.S.: ✓ FOREIGN:
DOCKETED: 6-5-06 BY:
ACTION: Response Due
DUE DATE: 9-2-06
EXT: 1ST 12 2ND 11 2 3RD 12 2 06
DOCKET# ENOS0003 ATTY:

Office Action Summary	Application No.	Applicant(s)	
	09/843,550	BAMFORD ET AL.	
	Examiner	Art Unit	
	Akiba K. Robinson-Boyce	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Due to communications filed 3/8/06, the following is a non-final office action. Prosecution for this case has been re-opened. Claims 1-25 are pending in this application, have been examined on the merits, and are rejected as follows.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US 6,754,636), and further in view of Walker et al (US 6,332,129).

As for Claim 1, Walker et al. discloses a method comprising:

receiving the electronic price request for the buyer, (see Figs. IB, IOB, 26A, 26B);

in response to the electronic price request, performing a computer-executed act of determining whether title to the goods passes directly from the manufacturer to the buyer or through an intermediate e-market place (col. 20, lines 30-64);

Providing the buyer with a machine-readable signal for displaying the computed price, (Col. 33, line 63-col. 34, line 3, shows that the POS register receives a verification

signal and processes the transaction, which issues the buyer a receipt for an amount due).

Walker '636 does not specifically disclose the following, but does disclose displaying the price of the goods in Fig. 20, where the price needs to be computed if it is actually displayed, and Walker '636 also shows that once the buyer offer has been accepted by the seller, a freeze may be place on the buyer's funds for the amount of the product price, plus any applicable tax amount calculated, thus indicating that the total price [including tax] is computed to be deducted from the buyer's funds in col. 30, lines 36-40.

However, Walker et al '129 discloses:

computing a price of the goods to the buyer based at least partially on the determining act, (Col. 2, lines 7-21, shows an existing method where a customer first goes on-line to purchase an airline ticket, makes a price offer, however, upon rejection of the price offer, a representative directly from the manufacturer [the airline] contacts the customer and counter-offers a price to the customer). Walker et al '129 discloses this limitation in an analogous art for the purpose of showing that a price determination must be made as a result of the customer obtaining the airline package directly from the manufacturer instead of making the purchase through the website on the Internet.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to compute a price of the goods to the buyer based at least partially on the determining act with the motivation of showing that the price will vary

according to whether or not the buyer purchased goods directly from the manufacturer, or through an intermediate e-market place.

As for Claim 2, Walker et al. '636 further discloses the method wherein a first pricing regime is implemented when it is determined that title to the goods passes directly from the manufacturer to the buyer (This is inherently true for all the direct transactions between the buyer and manufacturers. Otherwise, the manufacturer will commit fraud by not delivering the title to the buyer who paid for the goods. See Supra Figs. IOB, 26A, B).

As for Claim 3, Walker et al. '636 further discloses the method, wherein when it is determined that title passes through an intermediate e-market place, the method further includes determining whether to implement the first pricing regime or a second pricing regime (see Supra column and col. 36, lines 7-19; col. 37, lines 15-30).

As for Claim 4, Walker et al. '636 further discloses the method including the step of determining whether to discount a price (see Id.).

As for Claim 5, Walker et al. '636 further discloses the method, wherein a discount is determined based on volume of a current order (see supra column 37).

As for Claim 6, Walker et al. '636 further discloses the method, wherein a discount is determined based on: a stocking/handling charge (the buyer's address or location is pertinent to this, see col. 37, lines 5-30).

As for Claim 7, Walker et al. '636 further discloses the method including the step of determining whether to customize the price (see Supra columns for customizing the price for a specific customer).

As for Claim 8, Walker et al. '636 further discloses the method, wherein the price is customized based on: geographic region, customer information, product line information, manufacturer information (see Supra column 37).

As Claim 9, Walker et al. '636 discloses a computer having logic programmable to execute method acts, method acts comprising:

receiving the electronic request form the buyer, (see Figs. IB, IOB, 26A, 26B);

in response to the electronic request, determining whether title to the goods passes directly from the manufacturer to the buyer or through an intermediate e-market place (col. 20, lines 30-64);

Providing the buyer with a machine-readable signal for displaying the computed price, Col. 33, line 63-col. 34, line 3, shows that the POS register receives a verification signal and processes the transaction, which issues the buyer a receipt for an amount due).

Walker '636 does not specifically disclose the following, but does disclose displaying the price of the goods in Fig. 20, where the price needs to be computed if it is actually displayed, and Walker '636 also shows that once the buyer offer has been accepted by the seller, a freeze may be place on the buyer's funds for the amount of the product price, plus any applicable tax amount calculated, thus indicating that the total price [including tax] is computed to be deducted from the buyer's funds in col. 30, lines 36-40.

However, Walker et al '129 discloses:

computing a price of the goods to the buyer based at least partially on the

determining act, (Col. 2, lines 7-21, shows an existing method where a customer first goes on-line to purchase an airline ticket, makes a price offer, however, upon rejection of the price offer, a representative directly from the manufacturer [the airline] contacts the customer and counter-offers a price to the customer). Walker et al '129 discloses this limitation in an analogous art for the purpose of showing that a price determination must be made as a result of the customer obtaining the airline package directly from the manufacturer instead of making the purchase through the website on the Internet.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to compute a price of the goods to the buyer based at least partially on the determining act with the motivation of showing that the price will vary according to whether or not the buyer purchased goods directly from the manufacturer, or through an intermediate e-market place.

As for Claim 10, Walker et al. '636 further discloses the logic, wherein a first pricing regime is implemented when it is determined that title to the goods passes directly from the manufacturer to the buyer (This is inherently true for all the direct transactions between the buyer and manufacturers. Otherwise, the manufacturer will commit fraud by not delivering the title to the buyer who paid for the goods. See Supra Figs. IOB, 26A, B).

As for Claim 11, Walker et al. '636 further discloses the computer, wherein when it is determined that title passes through an intermediate e-market place, the method further includes determining whether to implement the first pricing regime or a second pricing regime (see Supra column and col. 36, lines 7-19', col. 37, lines 15-30).

As for Claim 12, Walker et al. '636 further discloses the logic programmable to determine whether to discount a price (see Id.).

As for Claim 13, Walker et al. '636 further discloses the logic, wherein a discount is determined based on volume of a current order (see Supra column 37).

As for Claim 14, Walker et al. '636 further discloses the logic, wherein a discount is determined based on: a stocking/handling charge (the buyer's address or location is pertinent to this, see col. 37, lines 5-30).

As for Claim 15, Walker et al. '636 further discloses the logic programmable to determine whether to customize the price (see Supra columns for customizing the price for a specific customer).

As for Claim 16. Walker et al. '636 further discloses the logic, wherein the price is customized based on: geographic region, customer information, product line information, manufacturer information (see Supra column 37).

As for Claim 17, Walker et al. '636 discloses a computer program product comprising:

computer readable code means for receiving the electronic price request from the buyer, (see Figs. IB, IOB, 26A, 26B);

computer readable code means responsive to receiving the electronic price request for determining whether title to the goods passes directly from the manufacturer to the buyer or through an intermediate e-market place, (col. 20, lines 30-64),

Computer readable code means for providing the buyer with a machine-readable signal for displaying the computed price, Col. 33, line 63-col. 34, line 3, shows that the

POS register receives a verification signal and processes the transaction, which issues the buyer a receipt for an amount due).

Walker '636 does not specifically disclose the following, but does disclose displaying the price of the goods in Fig. 20, where the price needs to be computed if it is actually displayed, and Walker '636 also shows that once the buyer offer has been accepted by the seller, a freeze may be place on the buyer's funds for the amount of the product price, plus any applicable tax amount calculated, thus indicating that the total price [including tax] is computed to be deducted from the buyer's funds in col. 30, lines 36-40.

However, Walker et al '129 discloses:

computer readable code means for computing a price of the goods to the buyer based at least partially on the determining, (Col. 2, lines 7-21, shows an existing method where a customer first goes on-line to purchase an airline ticket, makes a price offer, however, upon rejection of the price offer, a representative directly from the manufacturer [the airline] contacts the customer and counter-offers a price to the customer). Walker et al '129 discloses this limitation in an analogous art for the purpose of showing that a price determination must be made as a result of the customer obtaining the airline package directly from the manufacturer instead of making the purchase through the website on the Internet.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have computer readable means to compute a price of the goods to the buyer based at least partially on the determining act with the motivation of

showing that the price will vary according to whether or not the buyer purchased goods directly from the manufacturer, or through an intermediate e-market place.

As for Claim 18, Walker et al. '636 further discloses the computer program product, wherein a first pricing regime is implemented when it is determined that title to the goods passes directly from the manufacturer to the buyer (This is inherently true for all the direct transactions between the buyer and manufacturers. Otherwise, the manufacturer will commit fraud by not delivering the title to the buyer who paid for the goods. See Supra Figs. IOB, 26A, B).

As for Claim 19, Walker et al. '636 further discloses the computer program product, wherein when it is determined that title passes through an intermediate e-market place, the method further includes determining whether to implement the first pricing regime or a second pricing regime (see Supra column and col. 36, lines 7-19*, col. 37, lines 15-30).

As for Claim 20, Walker et al. '636 further discloses the computer program product including the computer readable code means for determining whether to discount a price (see Id.).

As for Claim 21, Walker et al. '636 further discloses the computer program product, wherein a discount is determined based on volume of a current order (see Supra column 37).

As for Claim 22, Walker et al. '636 further discloses the computer program product, wherein a discount is determined based on: a stocking/handling charge (the buyer's address or location is pertinent to this, see col. 37, lines 5-30).

As for Claim 23, Walker et al. '636 further discloses the computer program product including the computer readable code means for determining whether to customize the price (see Supra columns for customizing the price for a specific customer).

As for Claim 24, Walker et al. '636 further discloses the computer program product, wherein the price is customized based on: geographic region, customer information, product line information, manufacturer information (see Supra column 37).

As for Claim 25, Walker et al. '636 discloses a data processing machine programmed to perform operations, the operations comprising:

receiving the request for quote/receiving form the buyer an electronic message comprising an RFQ, (see Figs. IB, IOB, 26A, 26B);

transmitting an electronic message representing a price of the goods to the buyer based at least partially on the determining step (see Fig. 20 for displaying the price of the goods).

Walker '636 does not specifically disclose the following, but does disclose displaying the price of the goods in Fig. 20, where the price needs to be computed if it is actually displayed, and Walker '636 also shows that once the buyer offer has been accepted by the seller, a freeze may be place on the buyer's funds for the amount of the product price, plus any applicable tax amount calculated, thus indicating that the total price [including tax] is computed to be deducted from the buyer's funds in col. 30, lines 36-40. Also see col. 20, lines 30-64 for determining whether the seller is a manufacturer or a retailer.

However, Walker et al '129 discloses:

responsive to receiving the RFQ, determining a price of the goods based at least partially upon a manufacturer's specification as to whether title to the goods will pass directly from the manufacturer to the buyer or through an intermediate, (Col. 2, lines 7-21, shows an existing method where a customer first goes on-line to purchase an airline ticket, makes a price offer, however, upon rejection of the price offer, a representative directly from the manufacturer [the airline] contacts the customer and counter-offers a price to the customer). Walker et al '129 discloses this limitation in an analogous art for the purpose of showing that a price determination must be made as a result of the customer obtaining the airline package directly from the manufacturer instead of making the purchase through the website on the Internet.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have computer readable means to compute a price of the goods to the buyer based at least partially on the determining act with the motivation of showing that the price will vary according to whether or not the buyer purchased goods directly from the manufacturer, or through an intermediate e-market place.

Response to Arguments

4. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 571-272-6734. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A. R. B.
May 26, 2006

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER

Notice of References Cited	Application/Control No. 09/843,550	Applicant(s)/Patent Under Reexamination BAMFORD ET AL.	
	Examiner Akiba K. Robinson-Boyce	Art Unit 3639	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,332,129	12-2001	Walker et al.	705/26
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
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	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
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*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
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